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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application of: Julie R. Korenberg

Application No.: 08/956,991

Group Art Unit: 1644

Filed: October 23, 1997

Examiner: M. Tung

For: **Nucleic Acid Encoding DS-CAM  
Proteins And Products Related  
Thereeto**

Atty Docket No.: 9002-006-999

#14  
M.g.J  
6/3/99

**RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. § 121**

Assistant Commissioner for Patents  
Washington, DC 20231

**RECEIVED**

AUG 2 / 2000

TECH CENTER 1600/2900

Sir:

In response to the outstanding Office Action dated December 21, 1998, please consider the remarks below. Applicant submits concurrently herewith a Petition For Extension of Time for four months from January 20, 1999 up to and including May 20, 1999.

**REMARKS**

The Examiner has required a restriction under 35 U.S.C. § 121 to one of the following inventions:

- I. Claims 1-10, 12, 20, and 30, drawn to an isolated and purified nucleotide sequence coding for said receptor, a vector, a host cell expressing said receptor, a process and method for detecting said polynucleotide by hybridization and PCR amplification of said

nucleotide sequence, classified in class 536, subclass 23.5, class 435, subclasses 91.1, 325 and 320.1.

- II. Claims 11 and 24, drawn to an antisense oligonucleotide, classified in class 536, subclass 23.1 and 514, subclass 44.
- III. Claims 13-19, drawn to a DS-CAM protein, classified in class 530, subclass 350.
- IV. Claims 21-23, drawn to an antibody an composition, classified in class 530, subclass 387.9, 388.2 and 389.1 and class 424, subclasses 139.1, 141.1.
- V. Claims 25-27, drawn to a transgenic animal, classified in class 800, subclass 2.
- VI. Claims 28 and 30, drawn to a method for identifying a nucleic acid, classified in class 435, subclass 6.
- VII. Claim 29, drawn to a method for detecting a DS-CAM protein using an using an antibody, classified in class 435, subclass 7.1.

The Examiner contends that the inventions of Group I-VII are distinct, each from the other.

In response, Applicant provisionally elects with traverse the invention of Group I, claims 1-10, 12, 20 and 30. In addition, Applicants provisionally elect with traversal the invention of Group VI, claims 28 and 30 drawn to a method for identifying a nucleic acid.

Applicants respectfully request that the restriction requirement be modified to combine Groups I and VI together. The invention of Group I, claims 1-10, 12, 20, and 30, as indicated by the Examiner, drawn to an isolated and purified nucleotide sequence coding for said receptor, a vector, a host cell expressing said receptor, a process and method for detecting said polynucleotide by hybridization and PCR amplification of said nucleotide sequence. The invention of Group VI comprises claims drawn to (i) a method for identifying

nucleic acid using an oligonucleotide of claim 9 (placed in Group I) in a hybridization reaction; and (ii) single stranded DNA primers useful for amplification (claim 30 also placed in Group I). Applicants submit that the claims of Groups I and VI are commonly drawn to methods of identifying nucleic acid comprising hybridization or DNA amplification steps. Applicant submits that for one to properly search the subject matter of the claims of Group VI, one would necessarily have to search art relating to the subject matter of the claims of Group I. Accordingly, the claims of Group VI should be searched and examined together with the claims of Group I.

The M.P.E.P. § 803 (Sixth Edition, Rev. 3, July 1997) states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions (emphasis added).

Thus, in view of M.P.E.P. § 803, the claims of Group I and VI should be grouped as a single invention.

With respect to the Examiner's further requirement to elect a specific amino acid sequence from among sequences having SEQ ID Nos. 1, 2, 7, 8, 9, 10 or 11 if Group I is elected, Applicant provisionally elects with traverse, the sequence identified as SEQ ID No. 1.

Applicant retains the right to petition from the restriction requirement under 37 C.F.R. § 1.144.



### CONCLUSION

Applicant respectfully requests that the foregoing remarks be entered and made of record in the file history of the application. An early allowance of the application is earnestly requested.

Respectfully submitted,

Date: May 20, 1999

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